

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Kirk SCHECKEL et al.

Application No.: 10/698,358

Filed: November 3, 2003

For: RUTHENIUM BASED CONTAMINANT SORBENTS...



Art Unit: 1724

Examiner: I. C. Cintins

Washington, D.C.

Atty.'s Docket: SCHECKEL=1

Date: September 22, 2005

Confirmation No. 1126

THE COMMISSIONER OF PATENTS
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop Amendment
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is a [XX] REPLY: RESTRICTION REQUIREMENT AND REMARKS in the above-identified application.

- [] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.
 No additional fee is required.
 The fee has been calculated as shown below:

| | (Col. 1) CLAIMS REMAINING AFTER AMENDMENT | (Col. 2) MINUS | (Col. 3) HIGHEST NO. PREVIOUSLY PAID FOR | PRESENT EXTRA EQUALS |
|---|---|-------------------|---|----------------------------|
| TOTAL | * | ** 20 | | 0 |
| INDEP. | * | MINUS *** 3 | | 0 |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | | | |

ADDITIONAL FEE TOTAL

| SMALL ENTITY | |
|--------------|----------------|
| RATE | ADDITIONAL FEE |
| x 25 | \$ |
| x 100 | \$ |

| OTHER THAN SMALL ENTITY | |
|-------------------------|----------------|
| RATE | ADDITIONAL FEE |
| x 50 | \$ |
| x 200 | \$ |

OR

TOTAL

\$

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
 ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
 *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 60.00
 [] Second - \$ 225.00
 [] Third - \$ 510.00
 [] Fourth - \$ 795.00

Month After Time Period Set

[] Less fees (\$_____) already paid for ____ month(s) extension of time on _____.

Other Than Small Entity

Response Filed Within

- [] First - \$ 120.00
 [] Second - \$ 450.00
 [] Third - \$ 1020.00
 [] Fourth - \$ 1590.00

Month After Time Period Set

[] Please charge my Deposit Account No. 02-4035 in the amount of \$_____.

[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$_____.

[] A check in the amount of \$_____ is attached (check no.).

The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: SCHECKEL=1

In re Application of:) Art Unit: 1724
Kirk SCHECKEL et al.)
Appln. No.: 10/698,358) Examiner: I. C. Cintins
Filed: November 3, 2003) Washington, D.C.
For: RUTHENIUM BASED INORGANIC) Confirmation No. 1126
AND ORGANIC CONTAMINANT ...) September 22, 2005

REPLY TO RESTRICTION REQUIREMENT AND REMARKS

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

The Office Action mailed August 23, 2005, in the nature of a requirement for restriction, has been carefully reviewed. Favorable consideration is respectfully requested.

Restriction has been required among what the Examiner considers to be patentably distinct species of the claimed invention, as follows:

1. Contaminant species
2. ruthenium species
3. support material species
4. material purified species.

Applicants hereby elect, with traverse, the following species:

1. Arsenic as contaminant species

2. Ruthenium oxide (RuO) as ruthenium species
3. Sand as support material species
4. Water as material purified species.

This restriction requirement is traversed on multiple grounds. Including that the statutory standard has not been met; the classification system does not support a restriction requirement; applicants have a right to define their invention; there is no serious search burden; applicants have paid for an examination of all claims, and in any case, discretion should be exercised and restriction not required.

The Statutory Restriction Standard Has Not Been Met

The Patent statute states:

"If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis supplied, 35 U.S.C. 121]

The standard requires that the allegedly multiple inventions be "independent and distinct." This standard has not been met.

Classification Does Not Support a Restriction Requirement

The patent statute states:

"the Commissioner may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed." 35 U.S.C. 9

The classification system exists "...for the purpose of ...determining novelty, not to determine whether a claim

defines multiple inventions which may or may not be independent and distinct."

Applicant Has a Right to Define the Invention

By requiring restriction, applicants are deprived of their statutory rights under 35 U.S.C. 112 to have "claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention." The Examiner has, in effect, carved out a portion of applicants' invention and rejected it under the guise of a restriction requirement under 35 U.S.C. 121. This the commissioner may not do.

The Search Here Does Not Impose a Serious Burden

MPEP Section 803 requires that the examiner examine the application on the merits if the search and examination of an entire application can be made without serious burden, even though it includes claims to independent or distinct invention. The Examiner has made no showing that a search of this number of subclasses is a serious burden, particularly in light of the online searching system in which one can create subclasses by combining subclasses and/or key words. The burden of proof to show "serious burden" is on the Examiner. This burden has not been met.

Applicant Has Paid for Examination of All Claims

Having paid an application fee, applicants are entitled to have the Examiner determine the novelty and non-obviousness of the subject matter claimed. If this requires a search of three or more subclasses, so be it. If the position of the Examiner is accepted, applicants will be burdened with the expense of additional applications. These expenses include government filing fees, issue fees and maintenance

fees, in addition to attorneys' fees and the value of the time that the inventor will necessarily spend during prosecution.

Restriction is Discretionary

Even if the statutory standard has been met, discretion should be exercised in this case and restriction not required for the reasons given herein.

Withdrawal of the restriction requirement is respectfully requested.

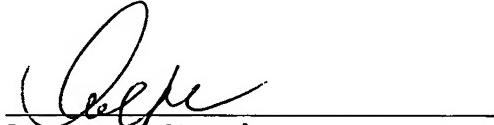
If the restriction requirement is maintained, it will be clear on the record that the PTO considers the groups to be patentably distinct from one another *i.e.*, *prima facie non-obvious* from one another. This means that a reference identical to the one group would not render the other group *prima facie* obvious.

Favorable consideration and examination of all pending claims on the merits are respectfully requested.

Respectfully submitted,

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